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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,542	06/06/2001	Ruk Peterson	LEH-33	6908

7590

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Milton Wolson, Esq.  
Malina & Wolson  
60 East 42nd Street  
New York, NY 10165

EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/875,542

Applicant(s)

PETERSON ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/19/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original specification for a "metatarsal guard having no space therein for facilitating flexion" as now claimed in claim 4. MPEP 2173.05 (i) requires that "Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement". Since there is no reference to "spaces" and/or "flexion" or the absence thereof in the original specification it is not clear what structures applicant intends to exclude/encompass with such language.

3. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4 the phrase "guard having no space therein for facilitating flexion" is confusing, and indefinite because no where in the original specification has such

language been used and therefore the structural limitations applicant intends to encompass with such language is unclear.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 4-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fortin (5457898).

Fortin shows a shoe comprising a sole (12), a toe cap (15), an upper (14), and a metatarsal guard (11) with a convex arch/instep portion (shown in figure 1), and a single right and complementary left leg (side portion which lead to the edge 13) as claimed. In reference to the limitations of "only a single", Fortin clearly shows a "single leg", the rear portion of the sides shown in the figures, the front elements could be considered to be a 'brace' or forward support. In reference to the limitation of "said convex arch portion having a section immediately rearward of the support legs which does not bear against the sole, Fortin clearly shows such at the location of the arrow from number 10 in figure 2.

2. In reference to the limitations of "having no space therein", the guard of Fortin does not contain any slits within the interior of the periphery of the guard, i.e. the actual guard is a solid piece of material with not slits or holes within the device, and since there is no basis or guidance in the original specification for limitations on "space", i.e. there is no guidance as to what structural limitations applicant is intending to encompass with such

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language this broad interpretation is appropriate. In reference to a "lip", elements 16 are considered to be a lip which overlap the toe cap but which do not contact/bear on the sole as claimed.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortin.

If applicant argues that the guard of Fortin contains "spaces" and multiple legs, it has been held that omission of an element and its function in combination where the remaining elements perform the same functions as before involves only routine skill in the art. In re Karlson, 135 USPQ 184. It would have been obvious to remove the flexibility elements/cuts (19 and 20) from the guard of Fortin to provide a stronger, stiffer, less expensive guard and shoe.

### ***Response to Arguments***

1. Applicant's arguments filed 4/19/04 have been fully considered but they are not persuasive.

In response to applicants arguments directed towards the limitation of "no space" (previously claimed as no slits), there is no basis for such a limitation in the original

specification and since there is no guidance as to what structures applicant intends to encompass with such language a broad interpretation of this language has been used as noted above in the rejections. The specification and description is silent as to any desire to specifically omitting slits/spaces or any reference to flexion.

In response to applicants' arguments directed towards the limitations of the "lip", these have been addressed above in the rejections.

In response to applicants' arguments directed towards Fortin, the legs (rear side portions) of Fortin clearly do not have any spaces therein. Applicant is reminded that claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974). There are no limitations in the claim which prevent reading solely the rear side portion of Fortin as the leg and the forward side portion as a support/other element.

In response to applicants' arguments directed towards the 103 rejection, the guard of Fortin if modified by omitting the elements/cuts/slits and their function, i.e. their increased flexibility, the remaining structures would clearly still perform their function of protecting the metatarsal area and providing safety to the wearers' foot.

### ***Conclusion***

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

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Telephone inquiries regarding other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners" M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (703) 308-0069. The examiner can normally be reached from 6AM - 4PM Mon-Wed . Starting November 8<sup>th</sup>, 2004 the examiner's telephone number will change to (571) 272-4559.

A handwritten signature in black ink, appearing to read 'Marie Patterson', with a long, sweeping horizontal line extending to the right.

Marie Patterson  
Primary Examiner  
Art Unit 3728